

REMARKS

The specification has been amended to update the priority information.

Claims 1-11 are pending in this application. Claims 3-5 and 7-11 have been withdrawn by the Examiner as being drawn to non-elected inventions.

Applicants have cancelled claims 3-5 and 7-11 without prejudice, and reserve the right to prosecute the subject matter of the cancelled claims in one or more related applications.

Applicants also have amended claims 1 and 2 for purposes of clarity.

New claims 12-33 have been added. New claims 12-33 are fully supported by the application as originally filed.

The new claims include two independent claims, *i.e.*, claims 12 and 24. Independent claim 12 is directed to a food composition comprising (a) at least one source of protein of animal or plant origin, or at least one source of a fatty substance of animal or plant origin, or at least one source of carbohydrate, or any combination thereof; and (b) a source of free tyrosine, wherein the amount of free tyrosine is at least 5% by weight of the total amount of tyrosine in the food composition. Claim 12 finds support in the specification at, for example, page 1, lines 14-17; page 4, lines 8-22 and 27-29; and claim 1 as originally filed.

Independent claim 24 is directed to a food composition comprising (a) a source of bound tyrosine; and (b) a source of free tyrosine, wherein the amount of free tyrosine is at least 5% by weight of the total amount of tyrosine in the food composition. Claim 24 finds support in the specification at, for example, page 1, lines 14-17; page 4, lines 8-22 and 27-29; and Example 2.

Dependent claims 13 and 25 recite that the amount of free tyrosine is at least 10%, 15%, 20%, 25%, or 30% by weight of the total amount of tyrosine in the food composition, and find support in the specification at, for example, page 4, lines 8-11 and 27-30.

Dependent claims 14-16 and 26-28 recite that the food composition is a cat food composition, a dog food composition, a mink food composition, a fox food composition, or a sable food composition, and find support in the specification at, for example, page 1, lines 30-31; and original claim 6.

Dependent claims 17 and 29 recite that the color of the hair or fur is black, and find support in the specification at, for example, Examples 2, 3, and 4.

Dependent claims 18, 19, 30, and 31 recite that the cat or dog food composition meets the standard of Nutrient Requirements of Cats or Dogs as published by the National Research Council of the United States of America, and find support in the specification at, for example, page 2, lines 17-21; and page 3, lines 20-23.

Dependent claims 20 and 32 recite that the food composition has a level of amino acids equal to or above acceptable nutritional standards, and find support in the specification at, for example, page 3, lines 19-27.

Dependent claims 21 and 33 recite that the food composition is a nutritionally well-balanced food composition, and find support in the specification at, for example, page 1, lines 13-14.

Dependent claim 22 recites that the food composition further comprises a source of bound tyrosine, and find support in the specification at, for example, page 8, lines 6-9; and page 10, lines 14-18.

Dependent claim 23 recites that the bound tyrosine is in the source of protein, and find support in the specification at, for example, page 3, lines 28, 29; and page 10, lines 10-12.

It is believed that no new matter is introduced by the amendments made herein.

I. THE REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH, FOR LACK OF ENABLEMENT SHOULD BE WITHDRAWN

Claim 1 is rejected under 35 U.S.C. § 112, first paragraph, allegedly for failure to comply with the enablement requirement. In the Office Action, the Examiner alleges that (1) the state of the prior art suggests that there is no means of preventing pigmentation abnormalities and/or improving the quality of fur by formulating a domestic carnivore food composition for this purpose (see Office Action, page 3, ¶2); (2) the experiments fail to demonstrate the prevention of pigmentation abnormalities and/or improving the quality of the fur (see Office Action, page 3, ¶3); (3) the treatment and would not be effective for all types of carnivores (see Office Action, page 4, ¶1); (4) there is no guidance provided by in the specification for the prevention of pigment abnormalities and/or improving the quality of the fur (see Office Action, page 4, ¶2); and (5) there is a high degree of unpredictability that exists in the art (see Office Action, page 4, ¶3).

Applicants respectfully disagree and would like to direct the Examiner's attention to Example 2 in the instant application. In said example, cats on two specialized farms were given a claimed food composition over many months, during which no problem of

discoloration which is often found on cats raised in such farms occurred. The qualities of the fur on said cats were also judged to have improved compared with cats fed with commercially available foods containing no free tyrosine. Contrary to the Examiner's allegation, the experiments described in the specification clearly demonstrate a food composition of claim 1 for preventing pigmentation abnormalities and/or improving the quality of the fur of a domestic carnivore. Since general methods for measuring pigment abnormalities and fur quality, as well as changes thereof, were well known as of the November 1999 priority date of the instant application, Applicants submit that based on the teaching of the specification, the skilled artisan could readily determine, without undue experimentation, whether the food composition recited in claim 1 would prevent pigmentation abnormalities and/or improve the quality of the fur of any domestic carnivore.

In view of the foregoing, it is submitted that the rejection of claim 1 under 35 U.S.C. § 112, first paragraph, for lack of enablement is in error and should be withdrawn.

Applicants submit that the specification also provides enablement for new claims 12-33. For example, Examples 2-4 of the specification describe how to make and use a food composition comprising, *inter alia*, a source of free tyrosine in an amount that is at least 5% of the total amount of tyrosine in the food composition.

II. THE REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH, FOR INDEFINITENESS SHOULD BE WITHDRAWN

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, allegedly for failure to particularly point out and distinctly claim the subject matter which Applicants regard as their invention.

In response, Applicants has amended claim 1 such that it no longer recites both a broad recitation and a narrower statement of the broad recitation. Thus, the rejection is believed to be obviated and should be withdrawn.

III. THE DOUBLE PATENTING REJECTION SHOULD BE WITHDRAWN

Claims 1, 2 and 6 are rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-3, 6-8, 14-16, 19-21, 27-29, and 32-34 of U.S. Patent No. 6,641,835 ("the '835 patent").

Although Applicants disagree with this rejection, Applicants submit concurrently herewith a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) to overcome this

rejection. The '835 patent is related to the instant application, as the instant application is a continuation of the '835 patent. Furthermore, the '835 patent and the instant application are commonly owned by Royal Canin, S.A.¹

Such Terminal Disclaimer is believed to obviate this rejection.

IV. THE CLAIM REJECTIONS UNDER 35 U.S.C. § 102 SHOULD BE WITHDRAWN

Claims 1, 2 and 6 are rejected under 35 U.S.C. § 102(e) ("Section 102(e)") as allegedly being anticipated by U.S. Application No. 2001/0014442 to Morris *et al.* ("Morris"). This rejection is traversed.

Morris was filed on February 2, 2001, and is a continuation-in-part of U.S. Application No. 09/501,548, filed February 9, 2000. Thus, Morris' earliest possible effective filing date is February 9, 2000.

The instant application is a continuation of U.S. Application No. 09/703,522 ("the '522 application"), filed November 1, 2000, which claims priority to French Application No. FR 9913657, filed November 2, 1999. The claim for priority and the certified copy of the French application were submitted by Applicants and acknowledged by the Examiner in the '522 application. Applicants submit that the instant application as filed on July 31, 2003, is an accurate English translation of the certified copy of the French application submitted in the '522 application. A Statement Under 37 C.F.R. § 1.55(a)(4)(ii) to this effect is submitted concurrently herewith.

As discussed above, support for the amended claims and new claims can be found in the application as filed on July 31, 2003, which is an accurate English translation of the French application. Thus, the claims are supported by the disclosure of the French application, and should receive the benefit of the November 2, 1999 filing date.

Since Morris was not filed before November 2, 1999, Morris does not qualify as prior art under Section 102(e). Accordingly, withdrawal of this rejection is respectfully requested.

¹ A Petition Under 37 C.F.R. § 1.47(b) submitted by Applicants on July 24, 2001, (which was granted in a decision mailed August 30, 2001) in connection with the '835 patent shows that, as a result of contractual obligations of the three named inventors, Royal Canin, S.A. is the assignee of the entire right, title and interest in and to U.S. Patent No. 6,641,835, which issued on November 4, 2003.

CONCLUSION

As all rejections are believed to be overcome, all claims are believed to be in condition or allowance. Reconsideration and allowance of the present application are respectfully requested. An early notice to that effect would be appreciated. Should the Examiner not agree with Applicants' position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

Respectfully submitted,

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Enclosures